Immunocept, LLC, et al v. Fulbright & Jaworski Doc. 7

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

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WESTERN DISTRICT OF TEXAS
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IMMUNOCEPT, LLC, PATRICE ANNE LEE, AND JAMES REESE MATSON	§	
	§	
Plaintiffs,	§	
	§	
v.	§	CAUSE NO. A050A334 SS
	§	
FULBRIGHT & JAWORSKI, LLP,	§	
	§	
Defendant.	§	

DEFENDANT FULBRIGHT & JAWORSKI, LLP'S COMBINED RESPONSE TO PLAINTIFFS' MOTION FOR PARTIAL SUMMARY JUDGMENT OF INFRINGEMENT AND MOTION FOR JUDGMENT CONCERNING THE LEGAL INTERPRETATION OF CERTAIN CLAIM LANGUAGE, AND ALTERNATIVELY, RULE 56(f) MOTION FOR CONTINUANCE

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COMES NOW, Fulbright & Jaworski, LLP ("Fulbright"), and files this Combined Response[1] to Plaintiffs' Motion for Partial Summary Judgment of Infringement and Motion for Judgment Concerning the Legal Interpretation of Certain Claim Language (collectively "Motion"), and in support thereof, would respectfully show the Court as follows:

INTRODUCTION

Plaintiffs' sole cause of action is legal malpractice. **Exhibit B**[2] (Plaintiffs' First Amended Complaint). Their legal malpractice theory alleges that Fulbright negligently prosecuted the '418 patent and thereby caused them harm. Although the '418 patent protects a method for treating sepsis that is not even approved to market, Plaintiffs want this Court to hypothesize with them and make legal rulings about potential infringement. They ask this Court to take the unprecedented step of injecting a *Markman*-esque analysis into a negligence case that raises no infringement controversy.

Moreover, Plaintiffs' request for claim construction and legal conclusions of non-infringement is in an utterly strange posture: it is not set in the typical context of a plaintiff filing a declaratory action to redeem itself before a threatened infringement suit can be filed against it. Rather, here, the *patentee* is asking this Court *to gut its own patent by declaring what would* ***not*** *infringe.* Their request is frivolous; "it is not the purpose of a *Markman* hearing to seek to strategically limit a patent's claims under the guise of a genuine dispute as to meaning." *Level One Communs. v. Seeq Tech.*, 987 F. Supp. 1191, 1204 (D. Cal. 1997).

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[1] This Response addresses the two motions jointly, since the arguments to Plaintiffs' requested relief overlap somewhat. The combined page limit for responding to the motions is a total of 20 pages, although Fulbright does not use the entire allotment.

[2] **Exhibit A** is a verifying affidavit.

ARGUMENT AND AUTHORITIES

I. It is improper to issue legal rulings about Plaintiffs' infringement hypotheses.

There is no claim in Plaintiffs' complaint that requires the Court or jury to decide what methods and technologies might infringe the claims of the '418 patent. Plaintiffs' only plausible reason to clothe this malpractice case in hypothetical infringement issues is to create extra ammunition for jury argument. This is wholly improper, as it fails to present to the Court a proper ground for summary judgment; it abuses the Court's resources in asking for non-infringement and *Markman* rulings in a case devoid of patent infringement claims; and it invites the Court to issue impermissible advisory opinions. For any of these reasons, as we will explain more fully below, Plaintiffs' Motion should be denied.

A. Summary judgment procedure is reserved only for issues that are pled.

Rule 56 allows a party seeking to recover upon a ***claim*** to move for judgment in its favor on "any part" of that claim. *See* FED. R. CIV. P. 56(a) (permitting motion with respect to "all or any part" of a "claim, counterclaim, or cross-claim or to obtain a declaratory judgment"). But infringement is not "any part" of Plaintiffs' case — for the obvious reason that there is no accused device or method that presently threatens to infringe the '418 patent. It would therefore be anathema to summary judgment procedure to grant partial judgment on an issue that does not dispose of even part of a claim or defense. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986) ("One of the principal purposes of the summary judgment rule is to isolate and dispose of factually unsupported claims or defenses[.]").

Notably, Plaintiffs make no *attempt* to tie their requested relief to any element of their sole claim for legal malpractice. At best, they have precatory language about the purpose of the motion: "With this Motion for Partial Summary Judgment of Non-Infringement, Plaintiffs seeks

[sic] to establish just how harmful Fulbright's mistake has been to the scope, and thereby the value, of its patent." (Mot. For Partial Summary Judgment at 3). "Of course, a party seeking summary judgment always bears the initial responsibility of informing the district court of the basis for its motion, and identifying those portions of 'the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any,' which it believes demonstrate the absence of a genuine issue of material fact." *Celotex Corp.*, 477 U.S. at 323. Plaintiffs' vague Motion fails to identify and give notice of the precise grounds that would entitle them to judgment. Plaintiffs' Motion should be denied.

B. A *Markman* analysis has no place in a case based solely on negligence.

The purpose of conducting a *Markman* analysis is to give the jury a judicially determined interpretation of a patent before they decide whether or not it is infringed. This entails a two-step process whereby the judge first construes the patent's claims and then the jury determines whether an accused device infringes on those claims. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996).

It is *not* the purpose of a *Markman* analysis to allow patentees to set up an attack on their own patent by proving a hypothetical case of non-infringement. *See, e.g.*, *Vivid Technologies, Inc. v. American Science & Engineering, Inc.*, 200 F.3d 795, 806 (Fed. Cir. 1999) ("the patentee bears the burden of proving *infringement*") (emphasis added). Likewise, "it is not the purpose of a *Markman* hearing to seek to strategically limit a patent's claims under the guise of a genuine dispute as to meaning." *Level One Communs.*, 987 F. Supp. at 1204.

But Plaintiffs' Motions run them right into these improper purposes. According to Plaintiffs, "[t]he outcome of this action depends critically upon three purely legal issues of patent claim interpretation that Immunocept asks the Court to resolve before trial." (Mot. for Judgment Concerning the Legal Interpretation of Certain Claim Language at 1). The three cited issues are:

1. "whether, as a matter of law, the patent was so narrowly drafted by Fulbright that it permits others to use Immunocept's technique with impunity merely by combining it with any other sepsis treatment;"

2. "whether Fulbright had the ability to transform claim "preamble" language into effective claim limitations, by submitting arguments to the Patent Examiner that rely upon the preamble as if it were limiting;"

3. whether "'blood' and 'whole blood' as used in the claim carry the plain meaning that practitioners in this field would expect, namely, blood as drawn from the body, and not plasma or other products that could be made from blood."

Id.

Taking the issues one by one, Plaintiffs' intent is obvious. They are suggesting a perverse use of a *Markman* analysis so that they can conduct a mini-trial on theories that they believe might buttress their negligence case.

Issue one asks the Court to hold as a matter of law that "the patent was so narrowly drafted by Fulbright that it permits others to use Immunocept's technique with impunity" — in other words, that the '418 patent will not protect Plaintiffs' "technique" against infringement. This is backwards on many levels. First, infringement by what? Courts do not decide hypothetical infringement of a patent in the abstract. Since there is nothing—method, device, or product—presently threatening to infringe the '418 patent, Plaintiffs hypothesize examples of sepsis treatments to practice with their proposed technology. Consideration of such hypothetical methods would constitute an advisory opinion whose only value would be as fodder for argument. Second, a *Markman* analysis is limited to legal construction of disputed terms of the patent. Here, Plaintiffs propose to have the Court decide whether others could hypothetically use the Plaintiffs' technology without infringing. That is not an appropriate use of *Markman* claim interpretation analysis. Finally, this issue has no boundaries. If Plaintiffs are allowed a legal decision on what they believe would not infringe, then—following the slippery slope—Fulbright is entitled to a decision on what *would* infringe.[3]

Issue two asks the Court to hold as a matter of law that "Fulbright had the ability to transform claim 'preamble' language into effective claim limitations." In other words, that Fulbright had an alternative way to prosecute the '418 patent. This is a classic jury question that bears no relationship to the mandate of *Markman* that claims are to be construed by the Court. Fulbright's evidence will show that the '418 patent was rejected by the Patent Office several times before it ultimately amended the claim language to use "consisting of," that the client was eager to get some protection quickly, and that Fulbright discussed the amendment with Plaintiffs. If the Court were to instruct the jury about alternative ways Fulbright could (read: should) have prosecuted a patent, it would be error.

Issue three asks the Court to construe the terms "blood" and "whole blood." Plaintiffs fail to explain why these terms should be construed at all in a negligence suit in which the issue is the reasonableness of Fulbright's actions in prosecuting the '418 patent. If their purpose is to argue that Fulbright could and should have used different words, this too will be a matter for the jury to decide. It is unreasonable and improper to ask the Court to step in the shoes of the prosecuting attorneys ten years ago and determine what could and should have been done differently; the "breach" element of a negligence claim is decided by the jury.

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[3] Fulbright would also be entitled to demonstrate that Plaintiffs' own expert has recently revealed that other researchers may be testing a hemofilter outside the pore-size range claimed by Plaintiffs. On February 21, 2006, Plaintiffs' expert Rinaldo Bellomo testified that the large pore hemofilter he discussed in his report could have a nominal pore size of anywhere from 80 to 300 kD, and that pore-size testing is "extremely variable." **Exhibit C** at 14-16 (Depo. of R. Bellomo). If, as Bellomo has testified, filters with pore sizes other than the 100-150 kD range claimed in the '418 patent can yield the same (or better) results as the Plaintiffs' technology, there is a real question as to whether competitors could avoid infringing the patent by selling, for example, the 200 kD filter that has already been produced by Gambro. *Id.* at 17. Fulbright raises these issues not to ask the Court to resolve them, but to illustrate the Pandora's box that will be opened if this Court accepts Plaintiffs' invitation to evaluate what hypothetical methods might or might not infringe. Just as Plaintiffs seek a hypothetical determination that combining treatments with the '418 patent would not infringe the '418 patent, Fulbright would need to seek a determination that substituting existing filters with a nominal pore size of 200 kD would not infringe a patent that claims a range of 100-150 kD.

Plaintiffs' "legal issues" reveal that they consider themselves the victims of "non-infringement" and want to set up a hypothetical patent infringement case within a case where none exists. But since this is *not* an infringement case, the Court should have none of it. Consider the unamused response of the Federal Circuit in a case where plaintiffs pulled a similar stunt:

> This case is bizarre. A charade conducted by counsel for both sides led to a grant of summary judgment of non-infringement though no product accused of infringement was before the court. We are, accordingly, compelled to vacate the judgment.

Laitram Corp. v. Cambridge Wire Cloth Co., 919 F.2d 1579, 1580 (Fed. Cir. 1990).[4]

It is not surprising then that it is literally unprecedented in published cases to conduct a *Markman* analysis in a legal malpractice case that does not involve infringement claims. Plaintiffs do not even offer a case suggesting this is permissible, but merely assert, "This Court must interpret the term 'consisting of' and how it limits claim 1 of the '418 patent [citation] [sic]." (Mot. For Partial Summary Judgment at 5).

Apart from being unprecedented, it would also be particularly unwise to extend *Markman* analysis to the malpractice context. Indeed, the consequences of Plaintiffs' *Markman*-infused

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[4] The Court went so far as to quote its colloquy with counsel from oral argument:

The court:	But these [DXA-D] have never been produced, you told us.
CWC's counsel:	That's correct.
The court:	Then they aren't a product?
CWC's counsel:	They had never been produced when suit was brought.
The court:	Well, accuse [plaintiff] under Rule 11. Infringement suit without a basis. You don't go out and create hypothetical products and ask the district court to rule on infringement by a hypothetical product.

Id. at n.7.

malpractice theory are breathtaking. Patentees need only invent hypothetical ways to avoid infringement of their own patent in order to allege malpractice by their attorneys. If their hypothetical non-infringement is then blessed by the Court in a *Markman* determination, their negligence case draws strength from the Court-sanctioned version of "what could have been." The unsuccessful and unmarketable product (that by definition, nobody is copying) would find an alternative avenue for profiteering: the law firm that aided its creation. *Markman* analysis heretofore reserved for infringement cases would usher in the new frontier of malpractice liability.

C. The Constitution does not permit advisory opinions on hypothetical non-infringement.

"Federal Courts do not sit to decide hypotheticals or to issue advisory opinions." *Laitram Corp. v. Cambridge Wire Cloth Co.*, 919 F.2d 1579, 1581 (Fed. Cir. 1990); *see also United Public Workers v. Mitchell*, 330 U.S. 75, 89 (1947). A true "case or controversy" is required. U.S. CONST. art. III, § 2. This case or controversy requirement prevents federal courts from rendering advisory opinions or considering hypothetical or abstract questions. *Hall v. Beals*, 396 U.S. 45, 48 (1969).

While the difference between an abstract question and a justiciable case or controversy is one of degree, not discernible by any precise test, the basic inquiry is whether:

> the conflicting contentions of the parties . . . present a real, substantial controversy between the parties having adverse legal interests, a dispute definite and concrete, not hypothetical or abstract.

Babbitt v. United Farm Workers Nat'l Union, 442 U.S. 289, 297-98 (1979). A federal court is not to render "an opinion advising what the law would be upon a hypothetical state of facts." *Aetna Life Ins. Co. v. Haworth*, 300 U.S. 227, 241 (1937).

Plaintiffs in the instant litigation have unabashedly ginned up their own hypothetical state of facts and asked this Court to rule as to whether seven methods, if practiced with their proposed technology, would not infringe the '418 patent. (Mot. for Partial Summary Judgment at 5-6). This infringement question is a straw-man, since Plaintiffs have admitted that ***nobody is actually using their patented technology***. *See* **Exhibit D** at 171-74 (Depo. of J. Matson); **Exhibit E** at 116-17 (Depo. of P. Lee). Plaintiffs essentially ask this Court to conduct a *Markman* analysis and then determine whether each of seven different combination methods that exist only in Plaintiffs' imagination would infringe the claims as construed by the Court.[5]

One wonders why Plaintiffs limited themselves to *seven* nonexistent methods; they may as well have asked the Court to expend its valuable resources to render advisory opinions as to a myriad of medical procedures that nobody has ever suggested they wished to practice and to determine whether they would infringe the '418 patent. The Federal Circuit has refused to permit such use of the courts, and vacated a summary judgment of non-infringement where, "[o]n the present record, the parties have identified no specific product made, used, or sold by [the defendant] and thus subject to a charge of infringement . . . when suit was filed. On that basis, there was no actual case or definite and concrete controversy over which the district court might have exercised jurisdiction." *Laitram Corp. v. Cambridge Wire Cloth Co.*, 919 F.2d 1579, 1583 (Fed. Cir. 1990). The hypothetical "infringing" products in *Laitram* were "concocted solely for the purpose of the motion." *Id.* at 1581. The similarities to this case are striking:

> In its motion [for summary judgment of non-infringement], CWC was effectively and improperly saying to the district court, "if we make and sell any of these four 'possible constructions' please advise that we won't infringe." Federal Courts do not sit, however, to decide hypotheticals or to issue advisory opinions.

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[5] *Markman* did not alter the rule that the determination of infringement *vel non* is to be determined by the jury. 517 U.S. at 384.

Id. (footnote omitted). As in *Laitram*, a summary judgment of hypothetical non-infringement is wholly inappropriate here.

D. An advisory ruling would not dispose of any element of Plaintiffs' case.

It must be emphasized that the advisory rulings Plaintiffs have asked this Court to make do not impact their negligence case in the slightest. Plaintiffs have not even attempted to tie the legal rulings they request to any of the elements of negligence that they must prove at trial. To prevail, the Plaintiffs must show that, but for the alleged actions of Fulbright, a different result would have obtained. Until someone practices their patented technology with any of the seven hypothetical methods the Plaintiffs list, there is no occasion for any court to determine whether a method infringes the '418 patent. And if and when that occurs, the determination of such infringement will be made in a suit between the Plaintiffs and the alleged infringer – not a suit against a law firm.

II. Plaintiffs have not met their summary judgment burden.

To support a motion for summary judgment, "the moving party [has] the burden of showing the absence of a genuine issue of material fact, and for these purposes the material it lodged must be viewed in the light most favorable to the opposing party." *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 157 (1970).

As a threshold matter, it must be emphasized that the Plaintiffs have failed to attach summary judgment evidence that supports their arguments. The only evidence that even addresses their interpretation of the '418 patent is both conclusory and hearsay. *See* **Exhibit F** ¶5 (Declaration of (Plaintiff) J. Matson) ("I have been informed that the term 'consisting of' limits the claim to the single hemofiltering step recited after that phrase. If other steps are added to the hemofiltering step, I have been told that claim 1 will not cover two or more steps of treatment."). For this reason alone, the Court should dismiss their motions insofar as they call for interpretation of the '418 patent.

Substantively, the legal points raised by Plaintiffs, in addition to being irrelevant to the elements of their negligence cause of action, are not supported by recent case law. For example, Plaintiffs ambitiously claim that ***any*** additional step for treating sepsis, when hypothetically practiced with their proposed method, would not infringe the '418 patent. (Mot. for Judgment Concerning the Legal Interpretation of Certain Claim Language at 6). This is not so. The Federal Circuit has held that adding to an invention will still infringe a "consisting of" claim, a claim more narrowly construed than a "consisting essentially of" claim, if it adds an element that is "irrelevant to the invention." *Norian v. Stryker Corp.*, 363 F.3d 1321, 1332 (Fed. Cir. 2004).

In *Norian*, the patent at issue contained the following claim:

> A kit for preparing a calcium mineral, said kit consisting of: at least one calcium source and at least one phosphoric acid source free of uncombined water as dry ingredients; and a solution consisting of water and a sodium phosphate, where the concentration of said sodium phosphate in said water ranges from 0.01 to 2.0 M and said solution has a pH in the range of about 6 to 11.

Id. at 1331. The Federal Circuit observed: "while 'consisting of' limits the claimed invention, it does not limit aspects unrelated to the invention." *Id.* As a result, it found that adding a spatula to the chemicals listed in the disputed claim did not avoid infringement, because "a spatula is not part of the invention that is described" and the "spatula has no interaction with the chemicals, and is irrelevant to the invention." *Id.* at 1332.

In the same way, the "consisting of" language in the '418 patent would "not limit aspects unrelated to the invention." Taking (for example) the Plaintiffs' first hypothetical addition to the '418 patent technology – antibiotics – one reaches the same conclusion as the *Norian* court: antibiotics are "not part of the invention that is described;" they have "no interaction with the [hemofilter];" and they are therefore "irrelevant to the invention." *Id.* (paraphrased). The Plaintiffs have not shown the absence of a genuine issue of material fact, as they have not addressed the *Norian* standard.

Nor is it true, as the Plaintiffs claim, that "[a] preamble will always be limiting *if the applicant argues that it is during prosecution of the patent.*" (Mot. for Judgment Concerning the Legal Interpretation of Certain Claim Language at 6). First of all, Plaintiffs ignore the chronology of relevant events: they rely upon dicta in the 2002 *Catalina* case to support their opinion that, *in 1996*, Fulbright should have argued that the preamble created a limitation when the "consisting of" amendment was made. *See Catalina Marketing Int'l, Inc., v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002). Second, *Catalina* was an infringement suit wherein the preamble was examined as a possible limitation to be used against the patentee; there is no suggestion that an Examiner would consider an argument ***during the prosecution process*** that the preamble was a limitation that could be used to avoid prior art. *See In re Morris*, 127 F.3d 1048, 1053-54 (Fed. Cir. 1997) (noting the disparate standards for construing a patent by an Examiner during prosecution and by a court during an infringement suit).

Even in the context of litigation, the Federal Circuit has engaged in a case-by-case determination regarding whether or not preamble language is a limitation. For example, *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, dealt with the following method claim:

> A method for reducing hematologic toxicity in a cancer patient undergoing [t]axol treatment comprising parenterally administering to said patient an antineoplastically effective amount of about 135-175 mg/m2 taxol over a period of about three hours.

246 F.3d 1368, 1371 (Fed. Cir. 2001). The court in *Bristol-Myers* held that the preamble expression in that claim, "for reducing hematologic toxicity," was not a limitation, as it merely

expressed a purpose of the invention. The court noted that "[t]he steps of the [patented] method are performed in the same way regardless of whether the patient experiences a reduction in hematologic toxicity, and the language of the claim itself strongly suggests the independence of the preamble from the body of the claim." *Id.* at 1375. Likewise, the steps of hemofiltration are performed in the same way regardless of whether the method is used "for treating a pathophysiological state caused by a toxic mediator-related disease," and so an argument by Fulbright to the Examiner that the '418 preamble should be used as a limitation on the Plaintiffs' claim would have been inappropriate.

Finally, Plaintiffs' halfhearted attempt to obtain construction of the terms "blood" and "whole blood" as they appear in claim 1 to mean only "blood as drawn from the body, and not plasma or products that could be made from blood" is not supported. Although the patent does not specifically define "blood" as used throughout the specification, it uses "blood" to refer not only to blood as drawn from the subject but also to fluid returned to the subject after filtration. The Plaintiffs' argument cites quotations from the specification of the '418 patent that use "blood" to refer to both the arterial or venous blood prior to hemofiltration and to the fraction of that blood that returns to a vein. It is not clear that the other fraction of the blood after filtration, sometimes referred to in the specification as "ultrafiltrate," is not also "blood" within the usage of the patent specification or by those of ordinary skill in the art.

Additionally, it would be inconsistent to use the term "whole blood" in claim 1 in the context of defining the molecular weight of the molecules that would pass through the claimed filter if "blood" and "whole blood" were given the same construction. When different terms are used in patent claims, those terms are presumed to have different meanings.[6] *Forest*

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[6] This, in particular, is an argument where Plaintiffs are seeking to have the claims construed so as not to read on the plasma filtration of the prior art, and this clearly raises the question of whether the construction sought from the

Laboratories, Inc. v. Abbott Laboratories, 239 F.3d 1305, 1310 (Fed. Cir. 2001). To give the terms "blood" and "whole blood" the specific meaning sought by Plaintiffs would not only collapse the meaning of two different words into one — without a clear indication in the specification that they were intended to have the same meaning, but it would also give them a meaning that is clearly inconsistent with the use of "blood" in the specification of the patent. Plaintiffs' request for a construction of "blood" and "whole blood" raises genuine issues of material fact, and is but another example of an improper attempt to seek an advisory opinion. It is based only upon counsel's arguments and on no record evidence whatsoever. Plaintiffs' proposed construction should be rejected.

Plaintiffs have not met their summary judgment burden of proof; their Motion should be denied.

III. Should the Court decide to entertain Plaintiffs' infringement hypotheses, Fulbright requests a Rule 56(f) continuance to conduct further discovery and requests that the Court set a schedule for *Markman* discovery, briefing and hearing.

The Supreme Court allows dispositions by summary judgment only when the nonmoving party has had adequate opportunity to discover information that is essential to its opposition. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 n.5 (1986). Plaintiffs' motions asking the Court to conduct *Markman* claim interpretation and declare non-infringement of the '418 patent inject new issues into this case that have never been explored. There has been no discovery on hypothetically infringing methods (Plaintiffs have repeatedly confirmed ***that there are no infringing methods***). *See* **Exhibit D** at 171-74 (Depo. of J. Matson); **Exhibit E** at 116-17 (Depo. of P. Lee). Indeed, it would have been arguably improper for Fulbright to delve into

court is the "broadest reasonable meaning" test used in the Patent and Trademark Office for prosecution purposes or the narrower construction used in the courts consistent with the presumption of validity provided by 35 U.S.C. § 282.

these areas, as it would not have led to the discovery of relevant information. *See* FED. R. CIV. P. 26(b)(1).

In the unlikely event that this Court deems it appropriate to consider the merits of Plaintiffs' Motion, Fulbright respectfully requests a Rule 56(f) continuance to conduct additional discovery that bears directly on the merits of Plaintiffs' motions. *See* **Exhibit F** (Affidavit of J. Golub). Fulbright further requests that the Court enter a briefing and discovery schedule for the patent infringement and *Markman* issues raised by Plaintiffs, and set a date for a *Markman* hearing.

Additional discovery would be necessary because there would be significant issues to develop before the Court could make informed *Markman* and infringement rulings. For example, assuming that the Court finds it appropriate to construe claim 1 of the '418 patent, the first issue is the standard to be used for construction. Patent claims usually are construed by courts in connection with actions for infringement, in which the courts construe patent claims as presumed valid in accordance with the dictates of 35 U.S.C. § 282. On the other hand, when the issue is whether or not a claim presented to a patent examiner should be issued in a patent, the claims are given "the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed Cir. 1997). No presumption of validity applies to prosecution proceedings before the Patent and Trademark Office. Although Plaintiffs seek to construe the '418 patent as narrowly as possible, it would only be appropriate to construe the patent from the standpoint of the "broadest reasonable meaning of the words" as would be considered by the examiner, since the issue properly framed is the reasonableness of Fulbright's actions in *prosecuting* the '418 patent.

This threshold issue reveals only the tip of the iceberg of what must be considered to conduct a *Markman* analysis in a malpractice case. Factual and expert discovery would need to be conducted to determine the proper construction of disputed terms in the '418 patent. Discovery of the hypothetically infringing methods proposed to be practiced with the '418 method must be undertaken before the claims, as construed, could be applied to the hypothetically accused methods. These are fundamental issues to address and Plaintiffs' Motion should not be granted until the Court has allowed for additional discovery, expert analysis, and briefing to deal fully with these newly raised hypothetical patent infringement issues.

CONCLUSION AND PRAYER FOR RELIEF

Plaintiffs have failed to identify a ground for summary judgment (much less meet their evidentiary burden in showing entitlement to judgment), and their request for a *Markman* determination and a judgment of non-infringement in a negligence case is neither proper nor necessary, but rather invites the Court to issue impermissible advisory opinions. For these reasons, Fulbright respectfully requests that Plaintiffs' Motion be in all respects denied.

Alternatively, Fulbright requests that the Court grant a continuance under Rule 56(f) and establish a schedule for discovery, briefing, and a *Markman* hearing.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document was served as shown below on counsel of record on March 10th, 2006.

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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

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Civil Case No. A:05-CA-334 SS

Immunocept, LLC et al.

VS.

Fulbright & Jaworski LLP

Attachments to Document #: 71

Description: Defendant Fulbright & Jaworski, LLP's Combined Response to Plaintiffs' Motion for Partial Summary Judgment...

File Date: March 10, 2006

Prepared by: dm

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